AF 2700 #38

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Lester F. LUDWIG, et al.

Appln. No.: 09/072,549

Confirmation No.: 6658

Filed: May 5, 1998

For: MULTIPLEXING VIDEO AND CONTROL SIGNALS ONTO UTP

Docket No: CA1100

Group Art Unit: 2153

Examiner: D. Dinh

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Examiner's Answer dated September 25, 2002, Appellant responds as follows.

1) Concerning the Examiner's characterization of Appellant's summary of the invention (Examiner's Answer, pages 2 and 3), Appellant respectfully disagrees. It does not matter whether the problem as set forth in Appellant's Appeal Brief is mentioned in so many words in the application. The point is that the problem which Appellant identified in the Appeal Brief was a problem which existed in the art at the time of the invention, and is a problem which the invention solves.

2) Appellant also disagrees with the Examiner's statement that Appellant failed to disclose how Appellant solved the problem of transmission of "TV quality" video over

unshielded twisted pair (UTP). Appellant set this information forth in detail in the Appeal Brief, beginning at page 13.

3) Concerning the Examiner's characterization of Appellant's statement of issues (Examiner's Answer, p. 3), again Appellant respectfully disagrees, to the extent that the Examiner's re-casting of the issue masks the level of ordinary skill in the art, as reflected in the NVT-518 product which Appellant discussed in the Appeal Brief.

Appellant agrees that the issue with respect to enablement is whether the ordinarily skilled artisan would be able to transmit "TV quality" video signals over UTP without undue experimentation, based on the present application. However, Appellant's statement of the issue characterizes more accurately, and in better context, the level of ordinary skill in the art at the time the application was filed. The point is that the existence of the NVT-518 video transceiver (which was not prior art to the present invention, but which was completed and commercialized relatively close to and just before the filing date of the application), provides evidence of the level of ordinary skill in the art at the time of the filing of the present application. Mr. Nitzan's work, to which Dr. Ludwig refers in his Declaration, was ample evidence of the true level of ordinary skill in the art, working from the teachings of the present application.

Appellant has already discussed, beginning at page 13 of the Appeal Brief, how the present application contains disclosure in excess of that of the prior art on which the Examiner relies. The next step is to look at the information which Dr. Ludwig provided to Mr. Nitzan, as reflected in the present application, and how Mr. Nitzan, as one of ordinary skill, was able to make the NVT-518.

4) Appellant has the following comments regarding the Examiner's Grounds of Rejection (Examiner's Answer, pp. 4-10). The Grounds of Rejection appear primarily to be a repetition of the grounds of rejection set forth in the Final Rejection in this application, with two exceptions. First, at page 5 (second line from the bottom), the Examiner refers to "a matter of economic" rather than "a matter of design choice," as in the final Office Action. The Examiner made the same reference at page 7 (fourth line from the bottom).

In regard to the Examiner's change of terminology, there is a vast difference in Appellant's mind between economics and design choice. "Economics" implies that a technological solution existed, but that only economics prevented its implementation. There is no evidence of any such thing in the record, and the Examiner has not substantiated this position at any point during prosecution. All the Examiner has provided is a hindsight-tinged comment that utilizing a computer network "would have enabled video transmission over existing paths and reduced the need to run new wires" (Examiner's Answer, p. 6, lines 1 and 2). That solution may be easy to see in light of the present application, but viewed in light of Verhoeckx and Tompkins, it is abundantly clear that no such solution had presented itself previously.

As for the issue of whether the integration of a video UTP path with an existing computer network was a matter of design choice, the Examiner has not substantiated this position, either. Given what the existing wiring was at the time of the application, there is a vast difference between transmitting video over a phone line, which would be one kind of unshielded twisted pair (UTP) wiring, and transmitting video over computer network wiring, which is something

different. Again, Verhoeckx and Tompkins shed no light on this issue, either. Only improper hindsight reconstruction can form a tie between that prior art and the claimed invention.

5) At page 10 of the Examiner's Answer, the Examiner claimed to have given weight to the term "computer network". However, Appellant notes that the Examiner also states, in at least two places (e.g. Examiner's Answer, pp. 5 and 7), "the computer network as recited in the claim is merely nominal recitation." However, independent claims 1, 12, and 21 clearly recite a computer network which, among other things, defines a UTP communication path which is arranged for video signal transportation. The claims refer later to the recited video communication system as being configured to transmit multiplexed signals along the UTP communication path, that path being part of the claimed "computer network". The recitation is not nominal, and is entitled to more weight than the Examiner gave it. The term "computer network" clearly has meaning to those of ordinary skill in the art, and means something more than separate video cabling.

6) Regarding the Examiner's comment about the claims not being written in "means plus function" language (Examiner's Answer, pages 10-11), the Examiner is correct, but the Examiner then goes on to state, incompletely, that the claims are to be given their "broadest interpretation". However broad an interpretation the Examiner gives to claim terms, that interpretation must be consistent with the specification. *Rapoport v. Dement*, 254 F.3d 1053, 59 U.S.P.Q.2d 1215 (Fed. Cir. 2001); *In re Cortright*, 165 F.3d 1353, 49 U.S.P.Q.2d 1464 (Fed. Cir. 1999); *Ex parte Petersen*, 228 U.S.P.Q. 216 (Bd. Pat. App. and Inter. 1985); *Ex parte Petersen*, 228 U.S.P.Q. 216 (Bd. Pat. App. and Inter. 1985).

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Appellant submits that the Examiner's treatment is not consistent with the specification. Terms such as "computer network" and "communications control component" need to be construed as they are defined in the specification. Even if not limited to the precise embodiments disclosed, a "computer network" is not a phone line, and a "communications control component" in a "computer network" is not just any old piece of hardware.

As to the remaining points in the Examiner's Answer (pages 11-12), Appellant believes that he has addressed these issues in detail throughout the Appeal Brief, and will not rehash that discussion here.

For the reasons presented herein and in the Brief on Appeal, Appellant again respectfully requests that the Examiner's rejections be reversed, and the application passed to issue at the earliest opportunity.

Respectfully submitted,

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Date: November 22, 2002

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